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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|-------------------------|-----------------------------|------------------------|
| 10/708,467  | 03/05/2004  | Richard F. Wenstrom JR. | 022956-0256                 | 2466                   |
| 21125 7590 07/02/2007<br>NUTTER MCCLENNEN & FISH LLP<br>WORLD TRADE CENTER WEST<br>155 SEAPORT BOULEVARD<br>BOSTON, MA 02210-2604 |             |                         | EXAMINER<br>HOFFMAN, MARY C |                        |
|   |             |                         | ART UNIT<br>3733            | PAPER NUMBER           |
|   |             |                         | MAIL DATE<br>07/02/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/708,467

Applicant(s)

WENSTROM ET AL.

Examiner

Mary Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04/10/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/10/2007, 05/07/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, claims 1-18, in the reply filed on 04/10/2007, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 19-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 04/10/2007.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are informal and hand-drawn, e.g. the lines are uneven, see FIGS. 3A and 3B. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

Claim 11 is objected to because of the following informalities: In line 1 of claim 11, Applicant recites "method" and this should be changed to --device-- to be consistent with the claims. Also, claim 11 appears to be grammatically incorrect. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 4-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Scholl (U.S. Patent No. 6,110,175).

Scholl discloses a tunnel notcher and guidewire delivery device (FIG. 2,3) comprising an elongate member with proximal (ref. #14) and distal (ref. #16) ends and an inner lumen (ref. #24) extending therebetween, the inner lumen being adapted to receive a guidewire; and a cutting element disposed on a distal portion of the elongate member and adapted to remove bone within an opening of a bone tunnel. A distal portion of the distal end of the elongate member is substantially tapered. The cutting element is substantially wedge-shape and extends distally outward from the elongate member. The cutting element includes a distal-facing surface that is disposed at an acute angle with respect to a longitudinal axis of the elongate member. The distal-facing

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surface is substantially concave (see FIG. 3, ref. #26). The angle between the cutting element and the longitudinal axis of the elongate member is less than 90°. The angle is in the range of about 20° to 70°. The cutting element includes a base portion coupled to the elongate member and a cutting edge positioned a distance apart from the elongate member (ref. #28). The cutting edge is positioned distal to the base portion. The cutting edge that is positioned a distance apart from the elongate member and has a length that is less than a diameter of the elongate member. The cutting element is capable of creating a notch in bone having a substantially semi-circular shape. The device further comprising a plurality of indicia formed on a distal portion of the elongate member and adapted to indicate a depth of the elongate member within a bone tunnel (FIG. 4). The device further comprising a handle (ref. #22) disposed on a proximal portion of the elongate. The handle extends in a direction transverse to a longitudinal axis of the elongate member.

Claims 1-2, 5-12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bryant (U.S. Patent No. 5,645,545).

Bryant discloses a tunnel notcher and guidewire delivery device comprising an elongate member (FIG. 1, ref. #20) with proximal (approximately at ref. #22) and distal (ref. #24) ends and an inner lumen (col. 2, line 48 "cannulated") extending therebetween, the inner lumen being adapted to receive a guidewire (ref. #6); and a cutting element (ref. #32) disposed on a distal portion (ref. #30) of the elongate member and adapted to remove bone within an opening of a bone tunnel. A distal portion of the distal end of the elongate member is substantially tapered. The cutting element includes

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a distal-facing surface that is disposed at an acute angle with respect to a longitudinal axis of the elongate member. The distal-facing surface is substantially concave. The angle between the cutting element and the longitudinal axis of the elongate member is less than 90°. The angle is in the range of about 20° to 70°. The cutting element includes a base portion (ref. #34) coupled to the elongate member and a cutting edge positioned a distance apart from the elongate member. The cutting edge is positioned distal to the base portion. The cutting edge that is positioned a distance apart from the elongate member, and it has a length that is less than a diameter of the elongate member. The cutting element is adapted to create a notch in bone having a substantially semi-circular shape. The device further comprising a handle (pistol grip of ref. #8) disposed on a proximal portion of the elongate member. The handle extends in a direction transverse to a longitudinal axis of the elongate member. The device further comprises a locking mechanism (holes, ref. #23, and corresponding screws) adapted to lock the guidewire in a fixed position with respect to the elongate member. The locking mechanism is formed on a handle mated to the proximal end of the elongate member. The locking mechanism comprises a threaded member (screws (not shown), col.2, lines 56-60) disposed within a threaded bore formed in the handle, the threaded bore being in communication with the inner lumen of the elongate member.

Claims 1-3, 5-8, 12 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Weikel et al. (U.S. Patent Application Publication No. 2002/0032447).

Weikel et al. disclose a tunnel notcher and guidewire delivery device comprising an elongate member (FIG. 6, ref. #10, 34) with proximal (left) and distal (right) ends and

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an inner lumen extending therebetween, the inner lumen being adapted to receive a guidewire (ref. #12); and a cutting element (ref. #36,38) disposed on a distal portion of the elongate member and adapted to remove bone within an opening of a bone tunnel. The distal portion of the distal end of the elongate member is substantially tapered. The cutting element is disposed proximal to the substantially tapered distal portion of the elongate member. The cutting element includes a distal-facing surface that is disposed at an acute angle with respect to a longitudinal axis of the elongate member. The distal-facing surface is substantially concave. The angle between the cutting element and the longitudinal axis of the elongate member is less than 90°. The angle is in the range of about 20° to 70°. The cutting element is adapted to create a notch in bone having a substantially semi-circular shape. The device further comprising a handle (ref. #40, or ref. #24) disposed on a proximal portion of the elongate member. The handle extends in a direction transverse to a longitudinal axis of the elongate member. The device further comprising a locking mechanism adapted to lock the guidewire in a fixed position with respect to the elongate member (see FIGS. 3A-4A). The locking mechanism is formed on a handle mated to the proximal end of the elongate member.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER